

Remarks

Summary of the Office Action

Claims 1, 2, 4-30, 32-51, 53-61, 63-89, 91-110, 112-120, 122-148, 150-169, and 171-177 are pending in the application.

Claims 1, 2, 4-12, 15-30, 32-46, 49, 60, 61, 63-71, 74-89, 91-105, 108, 119, 120, 122-130, 133-148, 150-164, and 167 are rejected under 35 U.S.C. § 102(e) as being anticipated by Israel et al U.S. Patent 6,766,307 (hereinafter "Israel").*

Claims 13, 14, 72, 73, 131, and 132 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Israel in view of Murray et al. U.S. Patent 5,023,851 (hereinafter "Murray").

Claims 47, 48, 106, 107, 165, and 166 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Israel in view of Sloo U.S. Patent 5,895,450 (hereinafter "Sloo").

Claims 53, 112, and 117 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Israel in view of Eaglesham et al. Financial Times, October 16, 2000, page 25, "Online arbitration business law."

Claims 50, 51, 53-59, 109, 110, 112-118, and 168, 169, 171-177 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Israel in view of Cornelius U.S. Patent 6,629,081 (hereinafter "Cornelius").

* Applicants believe that the Examiner has mistakenly maintained the listing of claims rejected under 35 U.S.C. § 102(e) as being anticipated by Israel from the previous Office Action. Applicants have corrected this listing of claims to remove claims that have been cancelled (i.e., claims 3, 31, 52, 62, 90, 111, 121, 149, and 170) and that are presently rejected under 35 U.S.C. § 103(a) (i.e., claims 47, 50, 51, 53-59, 109, 110, 112-118, and 168, 169, 171-177).

Summary of Telephonic Interview

The Examiner and applicants' representative, Michael J. Chasan, Reg. No. 54,026 conducted a telephonic interview on September 20, 2005. Applicant and applicants' representative wish to thank the Examiner for the courtesies extended during the interview. During the telephonic interview, the Examiner clarified the objections made and positions taken in the Office Action. Applicants' representative and the Examiner also discussed potential amendments that could be made to the claims to further define the invention.

Summary Applicants' Reply

Applicants have amended claims 1, 4, 29, 45, 47, 60, 63, 88, 104, 106, 119, 122, 147, 163, and 165 to more particularly define the invention and to correct minor typographical errors. No new matter has been added and the amendments are fully supported and justified by the specification.

Reconsideration of this application in light of the following remarks is hereby respectfully requested.

Applicants' Reply to the Rejection of Claims 1, 60, and 119 Under 35 U.S.C. § 102(e)

Claims 1, 60, and 119 are rejected under 35 U.S.C. § 102(e) as being anticipated by Israel. The Examiner's rejection is respectfully traversed.

In response to applicants' reply to the previous Office Action mailed November 11, 2004, the Examiner maintains that Israel shows all of the elements of applicants' independent claims 1, 60, and 119. More particularly, the Examiner contends in the present Office

Action (and further explained during the telephonic interview) that applicants' claimed features of having a "case manager, who is an entity other than the user and the at least one party," that "guid[es] the user and the at least one party through a dispute resolution process," and "allow[s] the case manager to select a neutral" are all shown by the computer system of Israel, in spite of Israel's failure to show a Case Manager user.

Notwithstanding the Examiner's ongoing rejection, applicants believe that the Examiner has implicitly accepted applicants' primary position that applicants' claimed approach for managing the resolution of disputes is fundamentally different than that of Israel. Whereas applicants' claimed approach relies on a Case Manager user to actively participate in the dispute resolution process, Israel's approach is more like a "do-it-yourself" system that does not provide the benefit of a Case Manager user.**

While recognizing this fundamental difference, the Examiner has maintained the rejection of applicants' independent claims 1, 60, and 199 by arguing that the "do-it-yourself" computer system of Israel provides the same features of applicants' claimed Case Manager user without actually having such a user. That is to say that the Examiner contends that the computer system of Israel provides the same features as applicants' Claim Manager and thereby shows all of the elements of applicants' independent claims 1, 60, and 119.

** Applicants demonstrated in the reply to the previous Office Action how the users provided by the system of Israel (i.e., program user, program manager, and administrative personnel) are not the same as or similar to applicants' Claim Manager. This position was not disputed by the Examiner in the present Office Action or in the telephonic interview.

Applicants respectfully disagree with this rejection. "To anticipate a claim, the reference must teach every element of the claim." MPEP, at 2131. The Examiner acknowledges that Israel does not show a Case Manager user as required by applicants' independent claims 1, 60, and 119. Accordingly, irrespective of whether the computer system of Israel provides the same features as applicants' Case Manager user, Israel must actually teach a Case Manager user in order to anticipate applicants' independent claims 1, 60, and 119.

However, while applicants disagree with the Examiner's rejection, applicants have further amended independent claim 1, 60, and 119 in an effort to advance prosecution.

Applicants' amended independent claims 1, 60, and 119 clarify the role of the Case Manager user in managing the dispute resolution process. In particular, the dispute management application assigns a Case Manager user to manage a dispute management process at a second computer after a first user files a claim against at least one party at a first computer. The dispute management application notifies the Case Manager user of the assignment at the second computer and also provides the Case Manager with a plurality of dispute management features at the second computer. These dispute management features include the ability to select a neutral at a third computer to facilitate the dispute resolution process.

Israel does not show any of these features of applicants' amended independent claims 1, 60, and 119. In particular, Israel does not show a dispute management system wherein three different types of users (i.e., the user, the case manager, and the neutral) all interact with

a dispute management application from their respective computers to facilitate a dispute resolution process. Most importantly, Israel does not show a case manager user that is assigned by the dispute management application to manage and guide the parties through a dispute management process at a second computer and that is provided with a plurality of dispute management features, including the ability to select a neutral at a third computer. In the "do-it-yourself" system of Israel, a case manager user is not used. Instead, the users of Israel must attempt to guide themselves through the dispute management process without the assistance of any such user.

Accordingly, because Israel fails to show each feature of applicants' amended independent claims 1, 60, and 119 the rejection over Israel under 35 U.S.C. § 102(e) should be withdrawn.

Applicants' Reply to the Rejection of
Claims 29, 88, and 147 Under 35 U.S.C. § 102(e)

Claims 29, 88, and 147 are rejected under 35 U.S.C. § 102(e) as being anticipated by Israel.

Applicants' method and systems of independent claims 29, 88, and 147, are directed towards, generally speaking, providing dispute management features in a dispute management application that includes providing a case filing application for allowing users to file a claim and a Case Manager for managing the dispute.

The Examiner contends that Israel shows all of the features of applicants' independent claims 29, 88, and 147. More particularly, the Examiner contends that the Case Manager of applicants' independent claims 29, 88, and 147 is shown by the computer system of Israel.

As stated above with respect to applicants' amended independent claims 1, 60, and 119, Israel does not show applicants' claimed feature of a Case Manager user. However, while applicants disagree with the Examiner's rejection, applicants have amended independent claim 29, 88 and 147 in an effort to advance prosecution.

Applicants have amended claims 29, 88 and 147 to include the features of assigning a Case Manager user to manage the case using a third computer in response to receiving the complete case filing application at a first computer from a user at a second computer and allowing the Case Manager to indicate a dispute management feature for a dispute management application at the third computer and providing that feature to the user using the first computer.

Israel does not show any of these features of applicants' amended independent claims 29, 88 and 147. In particular, Israel does not show a case manager user that is assigned by the dispute management application to manage and guide the parties through a dispute management process at a third computer in response receiving a completed case filing application at a first computer and allowing the case manager user to indicate a dispute management feature using the third computer and providing that feature to the user using the first computer. In the "do-it-yourself" system of Israel, a case manager user is not used. Instead, the users of Israel must attempt to guide themselves through the dispute management process without the assistance of any such user.

Accordingly, because Israel fails to show each feature of applicants' amended independent claims 29, 88

and 147 the rejection over Israel under 35 U.S.C. § 102(e) should be withdrawn.

Applicants' Reply to the Rejection of
Claims 45, 104, and 163 Under 35 U.S.C. § 102(e)

Claims 45, 104 and 163 are rejected under 35 U.S.C. § 102(e) as being anticipated by Israel.

Applicants' amended independent claims 45, 104, and 163 are, generally speaking, directed towards approaches for preventing potential disputes from arising between a first user and at least one party by monitoring communications between a user and the at least one party. The monitored communications may be compared with dispute management criteria and based at least in part on this comparison, the dispute management application may determine whether a potential dispute will arise. The user of the system is notified of this potential dispute so that the user may avoid the potential dispute and preserve the business relationship with the other party. Embodiments of these approaches are described, for example, in applicants' specification at pages 53 and 54.

The Examiner has failed to respond to applicants' amendments and arguments set forth in applicants' reply to the previous Office Action mailed November 11, 2004. Instead, the Examiner has maintained the original rejection of independent claims 45, 104, and 163.

Applicants have further amended independent claims 45, 104, and 163 to further clarify applicants' claimed invention.

Applicants respectfully maintain that Israel has no facilities whatsoever for preventing potential disputes

from arising between a first user and another party by monitoring communications from the first user to the other party to determine potential dispute and providing dispute prevention information to the first user, as required by applicants' amended independent claims 45, 104, and 163. In sharp contrast to applicants' claimed invention, Israel only refers to a system for providing dispute resolution procedures for existing disputes between two parties.

Accordingly, because Israel fails to show each feature of applicants' amended independent claims 45, 104, and 163 the rejection over Israel under 35 U.S.C. § 102(e) should be withdrawn.

Applicants' Reply to the Rejection of
Claims 50, 109, and 168 Under 35 U.S.C. § 103(a)

Claims 50, 109, and 168 are rejected under 35 U.S.C. § 103(a) as being anticipated by Israel in view of Cornelius.

Applicants' method and systems of claims 50, 109 and 168 (and their dependent claims) are directed toward providing features for managing disputes or potential disputes between entities in different countries. As set forth in the claims, communications between two users are "monitor[ed]" to "identif[y] the country that the second user is communicating from." Based on that identification, the other user (i.e., the "first user") is provided with dispute management information appropriate for that country. For example, this information may include alternative dispute resolution clauses that are appropriate under a particular country's law. See, e.g., applicants' specification, page 56. This part of the claimed method and systems may be used, for example, before a dispute

arises to assist parties or dispute management personnel in specifying how future disputes are to be resolved.

A second part of the claimed method and systems involves providing dispute management features based on the identification of the country. Dispute management rules (e.g., arbitration rules) appropriate to the country are determined. Dispute management features appropriate to that country of the second user are then provided.

The Examiner concedes that Israel does not show determining the country of a user and providing the other user with a plurality dispute management features appropriate to the country of that user, as required by applicants' independent claims 50, 109, and 168. The Examiner attempts to remedy these deficiencies in Israel by combining Israel with Cornelius.

Cornelius refers to a system for account settlement and financing in an e-commerce environment. More particularly, Cornelius refers a "one-stop trade finance service via the Internet" that can be used in the international sale of goods. Cornelius, column 8, lines 14-15. Disputes between users of the system may be resolved according to international commerce rules. See, e.g., Cornelius, column 24, lines 43-64. However, Cornelius does not provide dispute management rules or features that are appropriate based upon a determination of the particular country of a user.

I. THE CITED REFERENCES DO NOT SHOW OR SUGGEST ALL OF THE ELEMENTS OF APPLICANTS' CLAIMS

Applicants respectfully submit that nothing in either Israel or Cornelius shows or suggests a system for international dispute managements that determines the country of the user and that provides a plurality of dispute management features having dispute management rules

appropriate to the determined country. Therefore, whether taken alone or in combination, Israel and Cornelius fail to show or suggest all of the features of applicants' independent claims 50, 109, and 168.

II. THE CITED REFERENCES TEACH AWAY FROM APPLICATIONS' INVENTION

Further, applicants respectfully submit that the combination of Cornelius with Israel teaches away from applicants' claimed invention. The system of Cornelius provides a system for buyers and sellers to participate in international trade and provides a framework for resolving disputes that may arise between these parties. According to Cornelius, the users agree in advance to predetermined rules in the event of an international dispute. Thus, one skilled in the art faced with the problem of international dispute resolution would not determine the country of the user and provide a plurality of dispute management features having dispute management rules appropriate to the determined country, as shown in applicants' claimed invention. Rather, one skilled in the art faced with this problem would use the system of Cornelius to have users agree in advance to predetermined dispute resolution rules.

Accordingly, because Cornelius does not determine dispute management rules appropriate to the determined country of the users, but instead relies on the users agreeing beforehand to abide by a certain set of rule, the combination of Israel with Cornelius teaches away from applicants' independent claims 50, 109, and 168.

III. THE EXAMINER HAS FAILED TO PROVIDE MOTIVATION TO COMBINE THE REFERENCES

In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so

found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01. Applicant respectfully submits that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence' of a motivation to combine. In re Dembiczak , 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside , 53 USPQ2d 1769 (Fed. Cir. 2000).

In support of the combination of Israel with Cornelius, the Examiner states that:

It would have been obvious to one skilled in the art to implement such [a] system because it would allow for dispute resolution between international entities. Increasingly, businesses are becoming more international, and are involved in international trades. US businesses have operations abroad and vice versa, and having a dispute resolution system that takes into account international or local laws/protocols is necessary in order to serve a global business environment. Office Action, page 3.

Applicants respectfully submit these are not motivations to combine Israel with Cornelius. Rather, the Examiner has merely listed the alleged benefit of applicants' novel invention as motivation to combine the references instead of pointing to an objective teaching in either Israel or

Cornelius that would lead one of ordinary skill in the art to combine these references. Thus, the Examiner has not provided motivation to combine Israel with Cornelius.

IV. THE EXAMINER HAS EMPLOYED HINDSIGHT
RECONSTRUCTION IN COMBINING THE REFERENCES

Applicant respectfully submits that the Examiner has employed hindsight reconstruction in combining the references. With the knowledge of applicants' novel system for managing disputes between entities in different countries, particular features of the prior art were identified for use in rejecting applicants' invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine, 5 USPQ2d at 1600. ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicants' own invention as a bridge between Israel and Cornelius. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See In re Dembiczak, 50 USPQ2d at 1617-1618.

V. CONCLUSION

Accordingly, the rejection of claims 50, 109, and 168 over Israel in view of Cornelius under 35 U.S.C. § 103(a) should be withdrawn.

Applicants' Reply to the Rejection of Claims 2, 4-28, 30, 32-44, 46-49, 51, 53-59, 61, 63-87, 89, 91-103, 105-108, 110, 112-118, 120, 122-146, 148, 150-162, 164-167, 169, and 171-177

The remaining dependent claims all depend from claims that are novel and non-obvious over the prior art.

Accordingly, for at least this reason (and applicants reserve the right to argue additional reasons should prosecution continue), the rejection of these claims should be withdrawn.


Contingent Request for Telephonic Interview

If for any reason the Examiner is unable to allow this application based on this Reply, applicants request a telephonic interview with the Examiner before issuance of the next Office Action.

Conclusion

For at least the reasons set forth above, applicants respectfully submit that this application is in condition for allowance. Reconsideration and prompt allowance of this application are respectfully requested.

Respectfully submitted,



Michael J. Chasan
Registration No. 54,026
Agent for Applicants

Fish & Neave IP Group
Ropes & Gray LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1105
Tel.: (212) 596-9000